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REMARKS

Instant claims 1-7, and 10-15 stand pending in the instant Application. The instant claims 10-14 are withdrawn by the Examiner. No new matter is added by the present amendment.

Support for new claim 15 may be found, for example, in the instant specification at page 5, lines 9-11.

Claim Rejections: 35 U.S.C. §102(b)

Claims 1-5 and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by Friel (U.S. 5,731,377), hereafter "Friel".

Instant claim 1 recites "an aqueous coating composition comprising...0.001 to 0.05 moles of chain transfer agent / kg monomer;..." There is no mention of a chain transfer agent in Friel, and neither has such ever been alleged in any rejection. Every limitation of the instant claims must be present in the reference in order for Friel to be a valid §102(b) reference.

The rejection has cited case law to the effect that "even though the product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself". However, the instantly recited process begets a different polymer than a polymer made from the same monomer mixture by the process of Friel.

There can be no question whatsoever that a process using a chain transfer agent will produce a different product to a process that does not. The instantly recited process by using a chain transfer agent will, in addition to providing a lower molecular weight polymer and polymers having different properties than polymers made with chain transfer agents, provide polymers comprising chain transfer agent residues. Such is known definitively to those skilled in the art. Please refer to, for example, "Textbook of Polymer Science, 3rd Edition", F.W. Billmeyer, Jr., John Wiley and Sons, N.Y., 1984, page 63: "Chain-transfer agents with transfer constants near unity are quite useful in depressing molecular weight in polymerization reactions." The chain transfer agent (CTA) residue is the resultant of the chain terminating interaction between the growing polymer chain and the CTE and is clearly shown by the fact that the CTA is consumed

during polymerization. Therefore, the initial premise that "the final products appear to be the same" is clearly erroneous.

The rejection, to be proper, must provide evidence that the product produced in Friel is the same as the product produced by the current inventive process and has failed to do this. The §102(b) rejection is, therefore, clearly improper and should be withdrawn.

Claim Rejections: 35 U.S.C. §103(a)

Claims 1-7 stand rejected under 35 U.S.C. §103(a) as obvious over Friel. The rejection states that the final products appear to be the same, and that it would have been obvious to one of ordinary skill in the art to obtain the presently claimed product with a different process. In addition, the rejection alleges that Applicant's data on pages 17-24 of the instant specification do not show how the emulsion polymers utilized by Friel are different or produce different products than presently claimed. Finally, the rejection alleges that a proper side-by-side comparison has not been made to show the products are different. The Board of Appeals found the Applicants' comparisons not commensurate in scope with the art.

Regarding instant claim 1, Friel fails to disclose any chain transfer agent, any polymer emulsion comprising the residue of a chain transfer agent, or any motivation to provide a polymer comprising any chain transfer agent residue. Claim 1 is thus allowable over the cited art.

Regarding instant claims 2-7, the applicants have established the criticality of the process in making a different product and have shown it with data. The applicants' Comparative Examples A, B, C and D represent, respectively, the same monomer composition (levels of monomer and Tg) as each of Examples 1 and 2. See the instant specification at page 17, line 6, to page 19, line 9. Likewise, the applicants' Comparative Examples E and F represent, respectively, the same monomer composition (levels of monomer and Tg) as each of Examples 5 and 6. See the instant specification at page 20, line 20, to page 21, line 12. Further, at the time the instant invention was made, the inventive process was non-obvious because the improvement of the resulting product is both remarkable and surprising. The Examples in the instant specification show that the process as instantly recited gives a product having from 10% (Ex. 1 v. Comparative Ex.

A) to 45% (Ex. 2 v. Comparative Ex. C) better scrub resistance, i.e. it gives a different product. See Table 4.1 on page 20 of the instant specification. A product and its properties are inseparable.

Accordingly, the applicants' showing of a different and improved product resulting from the use of the inventive process compared to the process currently practiced in the art should be a sufficient showing that the product-by-process for the new process is different (and improved) compared to the product-by-process for the conventional process. This comparison was held sufficient in the European Patent Office, where this application has already passed to allowance.

Thus, the product resulting from the inventive process is not obvious with respect to Friel. The §103(a) rejection should be withdrawn.

New claim 15:

Friel fails to disclose, teach or suggest any of the instantly recited sulfoethyl methacrylate and the phosphoethyl methacrylate, or any motivation to include the same in a polymer or emulsion thereof. Accordingly, instant claim 15 is allowable over Friel.

Reconsideration of Restriction Requirement:

The original application included claims 1-9. The applicants had cancelled claims 8 and 9, and submitted new claims 10-14. Claims 10-14 were withdrawn from consideration by the Examiner as being directed to a process of making the composition of instant claims 1-7. However, a composition and the method of making the same are considered to be one and the same invention. See *In re Ochiai*, 71 F.3d 1565 (Fed. Cir. 1995). Applicants have insured that instant Claim 10 includes all of the limitations of instant Claim 2. Accordingly, Applicants hereby respectfully request the rejoinder of Group I, claims 1-7, and Group II, claims 10-14 upon an indication of the allowability of the instant composition claims. See MPEP 8.21.04, 1st two paragraphs.

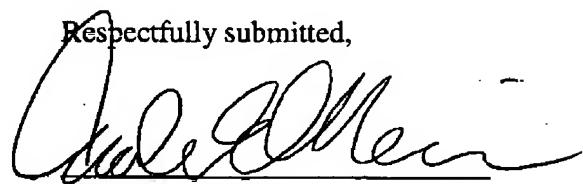
The applicants hereby also request reconsideration of the restriction of instant claims 10-14.

CONCLUSION

Based on the foregoing, the instant claims are believed to be in condition for allowance. Applicants' attorney thanks the Examiner for the time taken to review this response and Declaration.

Concurrently herewith, Applicants have filed a Request for Continued Examination and the requisite fee.

Respectfully submitted,



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